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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,227	08/06/2001	Abdul Rasoul Salman	417/9-1553b	8969

7590

06/19/2002

William J. Sapone, Esq.
The Offices of Coleman Sudol Sapone P.C.
714 Colorado Ave.
Bridgeport, CT 06605

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 06/19/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,227

Applicant(s)

SALMAN, ABDUL RASOUL

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment A filed on March 25, 2002 is acknowledged.

Claims 1-9 are included in the prosecution of this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of claims 1-2 and 4-6 under 35 U.S.C. 102(b) as being anticipated by Hughes et al (5322689) is maintained.

Response to Arguments

Applicant argues that Hughes discloses a topical aromatic releasing composition and not a liquid nasal passage cleaning composition as the instant invention. Further, the applicant argues that Hughes's composition contains other ingredients and cannot be applied to the nasal passages.

Applicant's arguments have been fully considered but they are not persuasive. In regards to the argument that Hughes's composition is not a cleaning composition, the examiner would like to point out that the composition contains decongestants and the composition is taught as a decongestant composition on column 2, lines 55-60; therefore the composition reduces congestion by expelling excess mucous. Secondly, the examiner would like to point out that the intended use of a composition does not hold patentable weight. As to the argument that Hughes composition is not in a liquid

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form, the examiner points out that an oil-in-water emulsion is in a liquid form. Further, Hughes does provide examples for the composition and therefore enables one of ordinary skill in the art to make and practice the invention.

Applicant's introduction of the term 'consisting essentially of' is noted. This amendment will not overcome the rejection because "the phrase does not necessarily limit the claims so as to exclude other things when the specification clearly indicates that other constituents may be present" (Ex parte Bonkidis, POBA 1966, 154 USPQ 444). Where the reference composition contains modifying components in addition to those of the claimed composition, the exclusion of such components by the phrase "consisting essentially of" does not impart patentability to the composition unless their omission results in a substantial change in the properties of the composition, because the phrase permits the inclusion of ingredients which do not materially affect the basic and novel characteristics of the claimed composition. In re Janakirama-Rao (CCPA 1963) 317 F2d 901, 137 USPQ 893; In re Hertz et al. (CCPA 1976) 537 F2d 549, 190 USPQ 461). Instant specification on page 2 and claim 6 clearly indicates that other ingredients such as an aroma agent and antipruritic in the composition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rejections of claims 3, 8, and 9 under 35 U.S.C. 103(a) as being unpatentable over Hughes et al, cited above in view of Bryce-Smith (5622724) in further view of Pan et al (5912007) are maintained.

Response to Arguments

Applicant argues that Hughes does not anticipate the method of introducing the composition into the nasal passage. Additionally the applicant argues that zinc sulfate nasal spray is not disclosed or suggested in Bryce-Smith or the cleaning of the nasal passage; therefore the combination is improper. Lastly, the applicant argues that the examiner's reliance on Pan is misplaced. Pan discloses an oral composition and there is not relationship between a liquid composition and a candy-based composition.

Applicant's arguments have been fully considered but they are not persuasive. In regards to applicant's argument that Hughes does not anticipate the method of cleaning the nasal passage, the examiner would like to point out that the method claims are rejected under 35 U.S.C. 103(a) and not under 35 U.S.C 102(b). Secondly, the examiner would like to point out that Hughes does teach a nasal passage cleaning composition as set forth above. Hughes composition is a decongestant composition, therefore elimination of mucous is implicit. Additionally, Hughes teaches a topical composition; therefore the composition may be applied anywhere and since the nasal passage is considered external Hughes composition may be applied to this area. The applicant argues that Bryce-Smith does not teach a zinc sulfate nasal spray, the examiner would like to point to the title and abstract, which clearly indicates the use of zinc sulfate in a nasal spray. Further, on column 4, lines 30-35, the Bryce-Smith states

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that nasal discharge in instantaneous after administration. Lastly, Bryce-Smith discloses a preferred preparation on column 5, lines 38-45 where zinc is combined with menthol, ethanol, and camphor.

In regards to agreements of the use of Pan et al, the examiner points out that Pan is used to teach the role of N-acetyl-cysteine in a composition regardless of the form (solid versus liquid) of the composition unless the applicant can provide evidence of the instant active agent changing its properties in a given form. Pan teaches the instant active agent as an expectorant and the motivation to use N-acetyl-cysteine in Hughes's composition is to have at least an additive effect is expelling mucous which is in essence the cleaning of the nasal passage.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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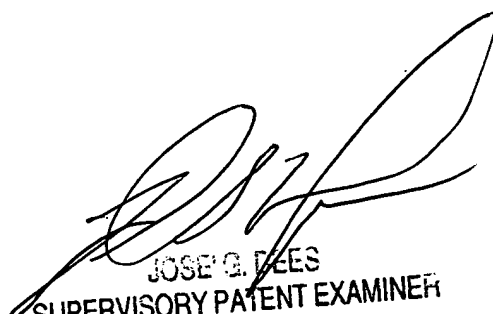
Any inquiry concerning this communication from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can be normally reached M-F from 7:30 am to 4:15pm.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached at (703) 308-4628. The fax number for this organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 308-1235.

SSG


June 4, 2002


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
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